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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,484	09/04/2003	Takayuki Ogino	9333/353	5870
74980	7590	04/24/2008	EXAMINER	
ALPINE/BHGL			DURAN, ARTHUR D	
P.O. Box 10395			ART UNIT	
Chicago, IL 60610			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,484

Applicant(s)

OGINO ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-20 are examined.

Response to Amendment

The Amendment filed on 1/25/2008 is sufficient to overcome the prior rejection. A new 35 USC 103 rejection has been made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11-13, 16, and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586).

1. Regarding claims 1, 11, and 16, Wilkman teaches of a system and method “for providing transaction control for purchasing decisions that involve the use of credits, debits, loyalty points, affinity points, promotions, or currency transfers.” (Abstract). In particular, Wilkman teaches of obtaining user information (Fig. 5; [0102]-[0106]) and loyalty information related to the user ([0066]; [0110]). Thereafter, a query is done for merchants who satisfy various factors, one of which is number of loyalty points. ([0110]; [0113]). The system then displays merchant information and their related promotion for merchants that match the criteria (i.e. number of points). ([0116]-[0118]).

Wilkman further discloses that queries for services available related to user points can be made ([110,113]).

Wilkman does not explicitly disclose searching for only an available facility which offers a point service available to the user within said cumulative number of points.

However, Tomita discloses searching for only an available facility which offers a point service available to the user within said cumulative number of points ([215, 284]; claim 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tomita's more searching for only facilities with services for available points to Wilkman's searching for facilities related to points. One would have been motivated to do this in order to provide facilities/services which are of interest to the user.

2. Regarding claims 2, 12, and 18, Wilkman teaches that the user can click on a promotion to find detailed information about the merchant, such as "driving distance, travel time, photo of location, photo of building, sample menu, list of prices, dining ratings, and so forth." ([0118]; [0129]).

3. Regarding claim 3-4, 13, 19-20, Wilkman teaches of storing promotion information related to merchants in a searchable database accessible to the user. ([0063], [0064]). Wilkman further teaches that the user can search and sort merchants and promotions based on the "number of loyalty points". ([0110], [0113]).

4. Claims 5-6, 14-15, and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Smith (US 6,314,365).

5. Regarding claims 5-6, 14-15, and 17, as stated above, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points. (Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion. (Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a “map feature that presents the user with a map of the location of the service as well as other information.” (Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant. However, Smith teaches of a system *and method for providing guidance to a vehicle using a users cell phone. (Smith, Abstract). In particular, Smith teaches that the user enters a destination into the cell phone (merchant destination) and the cell phone provides directions and a map to the user in a vehicle. (Smith, Fig. 1; Col 1, Lines 65-67; Col 2, Lines 1-61). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman’s teaching of a system on a cell phone for providing merchant information (including a map) based on a user’s query with Smith’s teaching of a cell phone that is used to navigate a vehicle to a desired location. One would have been motivated to do so because a navigational system is a known upgrade to a map based directional system.

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).

7. Regarding claims 7-10, Wilkman teaches of a system and method whereby a user enters in personal information, searches for a merchant/promotion based on various factors, is displayed a list of eligible merchants, and is given subsequent information related to merchant/promotion. (Wilkman, Abstract; [0110]; [0113]; [0118]; [0129]). Furthermore, Wilkman teaches that the system manages, tracks, and grants reward points. (Wilkman, [0110]; [0125]-[0126]).

Wilkman does not explicitly teach of awarding points to a user based on their driving activities. However, Mizuishi et al. teaches of a system and method for awarding points to a user based on characteristics of their actual driving. (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's point management system with Mizuishi et al.'s teaching of awarding points based on driving. One would have been motivated to combine the references because Wilkman teaches of a method for managing points while Mizuishi et al. teaches of a method for obtaining points.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Please see the addition of the Tomita reference above.

Also, Examiner notes that in regards to hindsight reasoning, Examiner notes that rigid preventative rules that deny factfinders recourse to common sense are neither necessary under our case law nor consistent with it. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Examiner further notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is

being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Yoshioka (20020004730) discloses searching for services related to cumulative points available ([33]); b) Sato (20030128391) discloses searching for services related to cumulative points available ([48]).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/
Primary Examiner, Art Unit 3622
4/22/08